

## **REMARKS**

### **Summary of the Office Action**

Claims 1-7, 9-15 and 17-19 were pending in the Office Action.

The Examiner objected to Claim 7 because of an alleged informality. The Examiner rejected claims 9 and 10 under 35 U.S.C. § 112. The Examiner rejected claims 1, 11-15 and 18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,860,510 to Kotler ("Kotler"). The Examiner rejected claims 1-3, 5-7, 9, 11-15, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over International Publication WO 00/42274 to Shortland et al. ("Shortland") in view of British Patent No. 690,863 to Oakley ("Oakley"). The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of U.S. Patent Publication No. 2001/0034983 to Fanti ("Fanti"). The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Shortland in view of Oakley and in further view of U.S. Patent No. 5,063,251 to Bergishagen ("Bergishagen"). The Examiner rejected claims 2-4 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kotler in view of Fanti. For the reasons detailed below, the rejections should be withdrawn, and the claims should be allowed to issue.

### **Applicant's Reply**

In this Response, Applicant amends claims 1, 4, 7, 9, 10, 18 and 19 to more distinctly claim what Applicant regards as the present invention, adds new claims 20 and 21, and addresses the Examiner's rejections. Support for the amendments to the claims can be found throughout the application. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's rejections. Thus, no subject matter has been relinquished by such amendments. Applicant reserves the right to pursue

these claims, prior versions of the claims, and/or the cancelled claims in another application.

Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on Applicant's Amendment and Remarks relative to the independent claim from which the dependent claims depend.

#### Claim Objections

Claim 7 was objected to because of an alleged informality – the use of the word “proud.” Applicants respectfully submit that “proud” finds support in the specification at page 3, line 31, and that the term has a known definition to one skilled in the art. However, in order to move prosecution forward and without relinquishing any subject matter, Applicant has amended claim 7 to recite “protruding,” as suggested by the Examiner in the Office Action. Therefore, Applicant requests the objection be removed.

#### Rejection under 35 U.S.C. §112

Claims 9-10 were rejected under 35 U.S.C. § 112 as being indefinite as depending on a previously cancelled claim. Applicant has amended claims 9 and 10 to depend from independent claim 1 and respectfully submits that the rejection under 35 U.S.C. § 112 is now moot.

#### Rejection under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 11-15 and 18 under 35 U.S.C. § 102(b) as being anticipated by Kotler.

Anticipation requires that each and every claimed feature be disclosed in a single prior art reference. Claim 1 has been amended to recite more clearly that the “ventilating

decorative floor covering for loose laying on an upper surface of a floor . . . is a single sheet plastics floor covering.” Claim 18 has been amended to recite more clearly that the “ventilating decorative floor covering for loose laying on the upper surface of the floor . . . is a single sheet plastics floor covering.”

Kotler does not disclose or suggest a single sheet plastics floor covering. Instead, Kotler describes a “modular tile for interlocking with other similar tiles to form a surface covering” (*see* Kotler, Abstract), which provides a cushioned surface suitable for use in an outdoor playground environment. Accordingly, Kotler does not disclose or suggest a “ventilating decorative floor covering for loose laying on an upper surface of a floor wherein the floor covering is a single sheet plastics floor covering” as recited in Claim 1 or a “combination of a floor having an upper surface and a ventilating decorative floor covering for loose laying on the upper surface of the floor wherein the floor covering is a single sheet plastics floor covering” as recited in claim 18 because the surface covering in Kotler is modular and formed by interlocking separate tiles. Therefore, claims 1 and 18 are patentable over Kotler for at least this reason.

Claims 11-15 depend, directly or indirectly, from claim 1. Therefore, claims 11-15 include all of the limitations of claim 1, in addition to the limitations recited in each individual dependent claim. Accordingly, because claim 1 is allowable over the cited art, claims 11-15 are also allowable for at least the same reasons applicable to claim 1. Furthermore, dependent claims 11-15 recite additional features not disclosed or suggested by the prior art of record.

For example, claim 12 further recites a “floor covering . . . which includes a wear layer.” The Examiner states that “[t]he flat finish of Kotler which is adapted for foot traffic is considered a wear layer (col. 5, lines 16-19).” Applicant respectfully disagrees, as Kotler does not disclose or suggest a wear layer. Rather, the top surface 30 of Kotler is merely the upper

surface of cushion plate 12 and not a further layer. (*See* Kotler, Column 5, lines 8-10).

Therefore, claim 12 is patentable over Kotler for at least this additional reason.

Claim 13 further recites a “floor covering . . . wherein the upper surface includes a decorative element such as a pigment and/or a PVC chip.” The Examiner states that “Kotler further disclose[s] the upper surface includes a flat finish or can be textured (col. 5, lines 16-19).” Kotler does not disclose or suggest “[a] floor covering . . . wherein the upper surface includes a decorative element such as a pigment and/or a PVC chip,” as recited in claim 13. The flat finish or texture of Kotler is not a “decorative element” and there is no disclosure or suggestion of the use of a “pigment and/or a PVC chip.” Therefore, claim 13 is patentable over Kotler for at least this additional reason.

Applicant has added new claims 20 and 21. Kotler does not disclose or suggest a floor covering which is “wound onto a core” as recited in claims 20 and 21. The modular flooring member of Kotler is rigid and not capable of being wound. The modular flooring member of Kotler is resilient and has a “generally flat configuration.” (*See* Kotler, Column 5, lines 40-41). Therefore, claims 20 and 21 are patentable over Kotler for at least this reason.

#### Rejection under 35 U.S.C. §103(a)

Claims 1-3, 5-7, 9, 11-15, and 17-19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shortland in view of Oakley.

Amended, independent claim 1 is directed to a ventilating decorative floor covering for loose laying on an upper surface of a floor wherein the floor covering is a single sheet plastics floor covering. Neither Shortland nor Oakley, considered alone or in combination, disclose or suggest a decorative floor covering with the recited combination of elements.

To reject claims in an application under Section 103, an Examiner must establish a *prima facie* case of obviousness. Using the Supreme Court's guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines "obviousness" as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. *KSR*, 550 U.S. \_\_\_, 82 USPQ2d 1385, 1396 (2007)). Importantly, the Court emphasized that a patent Examiner's analysis under Section 103 must be made explicit and there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicant respectfully submits that Examiner's analysis under Section 103 is not explicit and that the Examiner has not provided articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Shortland describes a stain resistant plastics floor covering. In contrast, Oakley describes a tile of india-rubber or rubber construction. Oakley states that "due to variation in atmospheric temperature or to periods of excessive humidity or to the sweating of concrete or like, there is a tendency for the india-rubber material to buckle and/or rise in spite of the fact that an adhesive fixing was used. Under these conditions the rubber tends to become tacky, gives off an offensive odour and rot sets in as happens when dry rot occurs in wood." (Oakley, page 1, lines 15-24). The objective of Oakley is to effect improvements in india-rubber tiles to avoid

these stated disadvantages. The flooring of Shortland is not constructed from india-rubber or rubber, so it would not be expected to suffer from the problems of the tiles of Oakley due to “atmospheric temperature or to periods of excessive humidity or to the sweating of concrete or like.” Therefore, a person of ordinary skill in the art would not have expected the teaching of Oakley to be relevant to that of Shortland. For at least this reason, Applicant respectfully submits that Shortland and Oakley, either alone or in combination, do not render obvious the subject matter of claims 1-3, 5-7, 9, 11-15, and 17-19.

Even assuming, *arguendo*, that a person of ordinary skill in the art were to combine the teachings of Oakley and Shortland, the combination would still not disclose or suggest all of the features of independent claims 1, 18 and 19. Neither Oakley nor Shortland disclose or suggest a single sheet plastics floor covering. Shortland discloses a floor covering which can be made of plastics material, but there is no disclosure of the floor covering being in the form of a single sheet. The floor covering of Oakley is made of either india-rubber or rubber, as opposed to plastics. Furthermore, the floor covering of Oakley is modular, each tile having a tongue 4 and a groove 5 which allow them to be “assembled into a covering when the hooks 3 on adjoining tiles are interlocked and the tongues 4 and grooves 5 interengaged with flush joints.” (Oakley, page 1, lines 68-74). Therefore, neither Oakley or Shortland, alone or in combination disclose all of the features of independent claims 1, 18 or 19 because claims 1 and 18 recite a “single sheet plastics floor covering” and claim 19 recites a “single sheet heterogeneous plastics floor covering.” Therefore, claims 1, 18 and 19 are patentable over Shortland and Oakley for at least this reason.

Since claim 1 is allowable, claims 2-3, 5-7, 9, 11-15 and 17 depending therefrom are also allowable.

Dependent claims 2, 3, and 5 recite additional features not disclosed or suggested by the prior art of record. For example, Shortland and Oakley do not disclose or suggest “a floor covering . . . wherein the lower surface of the floor covering is chemically or mechanically modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which it is applied,” as recited in claim 2. The Examiner points to page 8, lines 5-10 of Shortland, which discloses a plastisol paste, but Applicant respectfully points out that this paste is applied to the upper surface of a non-woven support. None of the examples in Shortland disclose or suggest that “the lower surface of the floor covering [is] . . . chemically or mechanically modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which it is applied.” Therefore, claims 2, 3 and 5 are patentable over Shortland and Oakley, either alone or in combination, for at least this additional reason.

Applicant has added new claims 20 and 21. Neither Shortland nor Oakley disclose or suggest a floor covering which is “wound onto a core” as recited in claims 20 and 21. Instead, the modular flooring member of Oakley is rigid and not capable of being wound. The tiles of Oakley may not be wound onto a core because tiles constructed from india-rubber or rubber would be too heavy and inflexible to be wound onto a core. Therefore, claims 20 and 21 are patentable over Shortland and Oakley for at least this reason.

Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Oakley and further in view of Fanti.

Claim 4 depends from claim 1. Therefore, claim 4 includes all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Fanti fails to cure the deficiency of Shortland and Oakley in failing to disclose a “single sheet plastics floor covering,” because the covering of Fanti is “a plastics tile, which is made of a number of discrete predetermined shaped components which are joined together.” (*See* Fanti, Paragraph 6).

Accordingly, because claim 1 is allowable over the cited art, claim 4 is also allowable for at least the same reasons applicable to claim 1. Furthermore, dependent claims 4 recites additional features not disclosed or suggested by the prior art of record.

For example, amended claim 4 recites that “the lower surface includes a blowing agent such that the lower surface of the floor covering is roughened.” Fanti, either alone or in combination with Shortland and Oakley, does not disclose or suggest that the “lower surface includes a blowing agent such that the lower surface of the floor covering is roughened,” as claim 4 recites. Instead, Fanti merely describes that “[p]referably, the lower surface of the discrete plastics components is roughened to enhance keying between the plastics components and the joining film and/or the surface on which the floor covering is to be laid.” (*See* Fanti, Paragraph 15). Nothing in Fanti discloses or suggests the lower surface includes a blowing agent, as claim 4 recites. Therefore, claim 4 is patentable over Shortland, Oakley and Fanti for at least this additional reason.

Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Oakley and further in view of Bergishagen.

Claim 10 depends from claim 1. Therefore, claim 10 includes all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Bergishagen fails to cure the deficiency of Shortland and Oakley because Bergishagen fails to disclose a “single sheet plastics floor covering” and instead describes the use of a blowing agent and cyclodextrin complex in floor tiles. (*See* Bergishagen Col. 1, lines 35-36). Accordingly, because claim 1 is allowable over the cited art, claim 10 is also allowable for at least the same reasons applicable to claim 1.

Additionally, a person of ordinary skill in the art would not be motivated to combine Shortland, Oakley and Bergishagen for at least the reasons stated above with respect to



combining Shortland and Oakley. Furthermore, Bergishagen discloses a composition comprising a cyclodextrin and a blowing agent. Neither Shortland nor Oakley disclose the use of a cyclodextrin. Therefore, it would not have been obvious to a person of ordinary skill in the art to combine the teachings of Shortland or Oakley with those of Bergishagen because the chemistry of the three disclosures is not compatible due to the absence of a cyclodextrin from the floor coverings of Shortland and Oakley. For at least this reason, Applicant respectfully submits that Shortland, Oakley, and Bergishagen, either alone or in combination, do not render obvious the subject matter of claim 10.

Claims 2-4 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Kotler in view of Fanti.

A person of ordinary skill in the art would not be motivated to combine Kotler and Fanti because the two floor coverings are constructed in a different and incompatible way. In Kotler, the lower surface of the disclosed modular flooring member is provided by flat, plastic support grid 11 which is formed by injection molding. (*See* Kotler, Column 4, line 65 - Column 5, line 2). In contrast, the plastics floor covering of Fanti is obtained by bonding several plastic film layers together. In Fanti, it is disclosed that during this bonding process, pressure can be applied by means of a rubber press to roughen the lower surface of the floor covering to enhance keying. (*See* Fanti, Paragraph 27). Therefore, the teaching of Fanti is not relevant to that of Kotler because the roughening of Fanti could not be applied to the modular tile of Kotler because it is constructed in a completely different way. For at least this reason, Applicant respectfully submits that Kotler and Fanti, either alone or in combination, do not render obvious the subject matter of claim 2-4 and 19.

Even assuming, *arguendo*, that a person of ordinary skill in the art were to combine the teachings of Kotler and Fanti, the combination would still not disclose or suggest all

of the features of claims 2-4 and 19. Claims 2-4 depend from claim 1. Therefore, claims 2-4 include all of the limitations of claim 1, in addition to the limitations recited in the dependent claim. Fanti fails to cure the deficiency of Shortland in failing to disclose a “single sheet plastics floor covering” as recited in claims 1 and 19, because the covering of Fanti is “a plastics tile, which is made of a number of discrete predetermined shaped components which are joined together.” (*See* Fanti, Paragraph 6). Accordingly, because claim 1 is allowable over the cited art, claim 2-4 are also allowable for at least the same reasons applicable to claim 1. Therefore, claims 2-4 and 19 are patentable over Kotler and Fanti for at least this reason. Furthermore, dependent claims 2-4 recites additional features not disclosed or suggested by the prior art of record.

For example, as discussed above with respect to claim 4, Fanti does not disclose or suggest that “the lower surface includes a blowing agent.” Therefore, claim 4 is patentable over Kotler and Fanti for at least this additional reason.

**CONCLUSION**

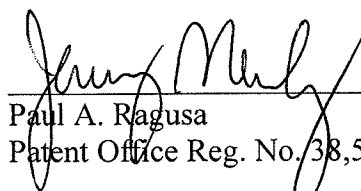
Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Applicant believes that pending claims 1-7, 9-15 and 17-21 are in condition for allowance. Withdrawal of all rejections and reconsideration of the amended claims is requested. An early allowance is earnestly sought.

Applicant believes that no additional fees are due in the timely filing of this response. In the event that fees are due, or overpayment is made, however, the Director is hereby authorized to charge payment of any such fees, or to credit any overpayment, to Deposit Account No. 02-4377.

If there are any remaining issues to be resolved, Applicant respectfully requests that the Examiner kindly contact the undersigned attorney for early resolution.

Respectfully submitted,

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